

REMARKS

Claims 1, 11-17 and 37 are currently pending. Claims 2-10 are canceled without prejudice for reasons unrelated to patentability. Support for new Claim 37 is found in the Specification as filed at page 21, lines 11-14. No new matter has been added herewith. The following addresses the substance of the Office Action.

Indefiniteness

Claims 2 and 11 were rejected under 35 U.S.C. § 112, Second Paragraph as being indefinite. Regarding Claim 2, the Examiner found that the phrase "a single bond, an alkylene group or an arylene group" did not encompass a 10-undecylenic acid derivative. The Examiner stated that the term "alkylene" signifies a double bond connecting two carbon atoms and concludes that the limitation is indefinite since 10-undecylenic acid does not contain a double bond.

The term "alkylene" has acquired different definitions over time. However, the term "alkylene" as used in the Specification was intended to cover chemical groups that include double bonds or not. Referring to the definitions of alkylene and alkandiy1 appended herewith, the term "alkylene" may be defined as an alkanediyl functional group, especially one having the free valencies of adjacent carbon atoms. Further, the word "alkandiy1" may be defined as any of a series of divalent radicals of the general formula C_nH_{2n} derived from aliphatic hydrocarbons. Thus, the Applicants believe that formula (1), wherein R_a is $R_1-CH=CH_2$, and wherein R_1 is a single bond, an alkylene group or an arylene group encompasses 10-undecylenic acid. Nevertheless, to be clear, the Applicants have amended the term "alkylene" to "alkyl", which also encompasses 10-undecylenic acid. As discussed below, the Applicants have also amended Claim 1 to encompass the subject matter of Claims 2-10.

Referring to Claim 11, the Examiner has stated that the recitation "a tyrosinase inhibitor comprising" is indefinite because a tyrosinase inhibitor is a single compound and the open language "comprising" leaves the claim open for inclusion of unspecified components. Claim 11 is amended by replacing the phrase with "A composition that inhibits tyrosinase comprising". In this way, the composition may include other components in addition to a tyrosinase inhibitor.

In view of the amendments to the claims and the foregoing remarks, the Applicants respectfully request removal of the rejection under 35 U.S.C. § 112, Second Paragraph.

Anticipation

Claims 1, 9, and 11-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nakajima et al., which discloses an arbutin ester compound that is encompassed by generic Claim 1. In particular, the Examiner pointed out that Nakajima et al. teaches arbutine cinnamate synthesized from arbutine and vinyl cinnamate. Formula (9) of the present invention includes arbutine cinnamate. In addition, the compounds described by formula (18) of the present invention encompass vinyl cinnamate. Accordingly, the Applicants have amended Claim 1 by incorporating the limitations of Claims 2-10, excluding those compounds disclosed by Nakajima et al. In particular, Claims 1 and 13 are amended to exclude formulas (9) and (18), which correspond to compounds wherein Ra is $R_1-C_6H_5$. In view of these amendments to the claims, the Applicants believe that the claimed invention is novel over Nakajima et al.

Obviousness

The following rejections were made under 35 U.S.C. § 103(a):

Claim 16 was rejected as being obvious over Nakajima et al., as applied to Claims 1, 9 and 11-14, and in further view of Lozano et al.

Claim 15 was rejected as being obvious over Nakajima et al., as applied to Claims 1, 9 and 11-14, and in further view of Japanese patent 2001-151623 to Kiyoshi et al.

Claim 17 was rejected as being obvious over Nakajima et al., as applied to Claims 1, 9 and 11-14, and in further view of Japanese patent 2001-151623 to Kiyoshi et al. and published international application WO 01/79241 by Weiss et al.

The Nakajima et al. reference was applied to claims 1, 9 and 11-14. However, Nakajima et al. does not teach the compounds described in the currently amended claims. Further, Lozano et al., Kiyoshi et al. and Weiss et al. do not teach the claimed compounds and they fail to fill the gap between Nakajima et al. and the instant invention. Thus, based on the cited references, one of ordinary skill in the art would have no reason to make the presently claimed compounds. Accordingly, the subject matter defined in amended claims is not obvious over the cited references. On the basis of the claim amendments and preceding remarks, removal of the rejection under 35 U.S.C. § 103(a) is respectfully solicited.

Application No.: 10/530,789
Filing Date: April 8, 2005

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of Applicants' amendments to the Claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

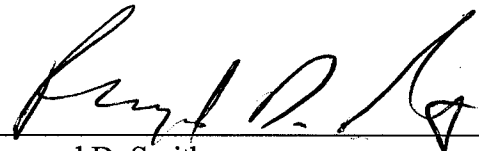
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

2 July 2008

By: _____



Raymond D. Smith
Registration No. 55,634
Agent of Record
Customer No. 20995
(949) 760-0404